REMARKS

The Office action has been carefully considered. The Office action rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,860,012 to Luu et al. ("Luu"). Additionally, the Office action rejected claims 2-15, 27-34, and 38-41 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of U.S. Patent No. 5,809,251 to May et al. ("May"). Further, the Office action rejected claims 16, 17, 19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over May in view of Luu. Still further, the Office action rejected claims 42 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of U.S. Patent No. 5,995,756 to Hermann et al. ("Hermann"). The Office action rejected claims 35 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and in further view of U.S. Patent No. 6,457,175 to Lerche et al. ("Lerche"). The Office action rejected claims 43-47, 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and in further view of Hermann. Finally, the Office action rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and in further view of Hermann and Lerche. Applicants respectfully disagree.

By present amendment, claims 1, 16, 27, and 42 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of

the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on March 30, 2004. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a method and system for installing management software on a remote client by using an installation service that does not require user intervention. This is accomplished by transmitting an installation service to a client machine, which when executed, installs the management software. Client machines that are candidates for the installation service are discovered by a data discovery manager that runs on a server. Once discovered, the installation service may be transmitted to the discovered client machine and then executed.

The installation service installs software without the need of a preexisting installation program already residing on the target machine, (or for that matter a version of a to-be-installed application program already residing on the target machine). Moreover, the installation service may be transmitted from a server machine to the client machine based on a connection initiated by the server to

that client. By transmitting an installation service that installs software, significant advantages over prior art are realized because the need for someone (such as each user or a team of administrators) to physically travel to each client machine and manually put the "special installation program" on that machine so that it can be present to do the application update, when later needed. Once installed, the management software allows the remote maintenance of client computers that includes, for example, deploying applications on the client computers, maintaining and upgrading applications, and removing applications.

Note that the above description is for informational purposes only, and should not be used to interpret the claims, which are discussed below.

§ 102 Rejection

Turning to the claims, claim 1, as amended, recites a method for installing software onto a remote client machine, comprising, initiating a connection at a server to the client machine, transmitting an installation service that installs software, the installation service transmitted from the server to the client machine based on the connection initiated by the server, and executing the installation service on the client machine, the executing independent of any installation program previously installed on the client machine.

The Office action rejected claim 1 as being anticipated by Luu. More specifically, The Office action contends that Luu teaches initiating a connection at

a server to the client machine. Column 1, lines 60-66 of Luu are referenced. Further, the Office action contends that Luu teaches transmitting the installation service that installs software, the installation service transmitted from the server to the client machine based on the connection initiated by the server. Column 2, line 2-6 of Luu are referenced. Still further, the Office action contends that Luu teaches executing the installation service on the client machine. Column 2, lines 2-6.

As discussed in the interview with the Examiner on March 30, 2004, applicants respectfully submit that the cited section of Luu does not teach or suggest the elements recited by in amended claim 1, including the concept of a transmitted installation service that installs software independent of any installation software previously installed on the client machine. More specifically, the installation service comprises a small number of files that are put on the client machine, one of which is a bootstrap install service. The client machine may then execute the installation service, essentially starting a bootstrap process that operates to access the client machine's registry and then connect the client machine to a server. The installation service then installs the remainder of the management software on the client machine from the server and it does so independent of any previously-installed installation program. See, generally, the summary of the specification. Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

In contrast, the method taught by Luu requires a program already present on Luu's machine that installs the software. More particularly, the Luu installation package 303 of FIG. 3 and 503 of FIG. 5 is a text file that comprises data to be operated upon (or carried out) by Luu's *special installation program* (302 of FIG. 3 and 601 of FIG. 6) *that is already stored* on the user workstation 202. The installation package is merely text data interpreted by this already-present "special installer program" of Luu, and, further, is not even a service as recited in claim 1.

For example, the Luu installation package is a text data file that is specific to each application program to be installed, and contains the differences between a baseline application software 501 of FIG. 5 and a to-be-installed updated application software 502 of FIG. 5. In fact, Luu teaches that the installation package is an IPACK format file (col. 5 lines 7-12), and that the already-present installation program 601 (or Installer) receives the installation package 602 and a personality file 603, to install the updated application software 604 (col. 7 lines 14-18) in the workstation 202.

Applicants submit that claim 1, as amended, is patentable over the prior art of record for at least the reasons discussed above.

§ 103 Rejections

The Office action rejected claims 2-15, which depend either directly or indirectly from claim 1 as being unpatentable over Luu in view of May. Applicants respectfully submit that dependent claims 2-15, by similar analysis discussed above with respect to claim 1, are patentable. As discussed above, Luu fails to disclose the recitations of claim 1 and, therefore, these claims are also patentable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 2 recites that initiating a connection includes discovering the client machine, *e.g.*, determining the location or other identification of client machines on the network. Applicants find no description in May of discovering a client machine. The Office Action concedes that May does not explicitly teach discovering the client machine. Instead, the allegation appears to be that May's MIS may have location information for each remote computer. However, in contrast to the claims, such location information is not taught as being inherently or expressly obtained by any discovery mechanism whatsoever in the prior art; discovery comes from applicants' teachings.

As another example, claim 13 recites (1) the installation service is a bootstrap service, (2) running the bootstrap service connects the client machine

to another server, and (3) transmitting additional software from the other server. Neither Luu nor May disclose any of these elements.

Moreover, regarding each of the claims 2-15, there is no teaching, suggestion, or motivation to combine Luu with May. Indeed, the method and system described in Luu and May are incompatible with one another, each addressing differing ways to update already existing software on a computer.

For example, Luu addresses a method and system to update applications on computers by analyzing the differences between a pre-updated software version and an updated software version, and transmitting those differences to the computer client for generating an updated version. A previously-installed installation program executes files describing difference between a baseline application and an updated application to generate an updated application from the baseline application.

On the other hand, May addresses a method and system to install updated software on a computer by determining the versions of the software on the computer, and if the versions indicate a need to update the software, transmitting new software to the computer, where a previously-installed installation program (again) loads the new software. May also addresses software metering by a remote computer of software usage on the computer. Absent applicants' teaching, applicants cannot find an indication anywhere in Luu or May of any motivation, suggestion, or teaching to combine Luu with May, that would somehow be directed towards the present invention.

As a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Turing to the next independent claim, claim 16 recites, as amended, a system for selectively installing management software onto remote client machines, comprising, a data manager for evaluating information associated with a plurality of discovered remote client machines, and for selecting one of the remote client machines as a selected client machine, a configuration manager for initiating a connection to the selected client machine, and an installation service transmitted by the configuration manager to the selected client machine, the installation service installing at least part of the management software on the selected client machine, the installing independent of any installation program previously installed on the client machine.

The Office action rejected claim 16 as being unpatentable over May in view of Luu. More specifically, the Office action contends that May teaches a configuration manager for initiating a connection to the client machine. Column 13, lines 47-48 of May are referenced. The Office action concedes that May does not explicitly teach a data manager, but contends that it does teach a medium for evaluating information on discovered remote client machines and that the selected client machine is the one in which the server connects to initially. Column 13, lines 47-55 of May are referenced. The Office further concedes that May does not teach transmitting an installation service for installing part of the management software on the selected client machine. The Office action, however, contends that Luu does disclose this recitation. Column 5, lines 10-15 and column 7, lines 18-20 of Luu are referenced. The Office action then concludes that it would have been obvious to a person skilled in the art at the time the invention was made to combine the teachings of May and Luu to arrive at the recitations of claim 16 because such a combination would allow for a self-executing package to install files for an application on a client machine. Applicants respectfully disagree.

As was discussed above, Luu is directed to a system where a previously installed installation program on Luu's machine installs the software, not the Luu installation package. Similarly, May discloses a system that addresses a method and system to install updated software on a computer by determining the versions of the software on the computer, and if the versions indicate a need to

update the software, transmitting new software to the computer, where a previously-installed installation program (again) loads the new software.

In contrast, claim 16 recites the installation service installing at least part of the management software on the selected client machine, the installing independent of any installation program previously installed on the client machine. Thus, applicants submit that claim 16, as amended, is patentable over the prior art of record for at least the reason discussed above.

The Office action rejected claims 17-26, which depend either directly or indirectly from claim 16 as being unpatentable over some combination of Luu and May. Applicants respectfully submit that dependent claims 17-26, by similar analysis discussed above with respect to claim 16 and claim 1-15, are patentable. As discussed above, Luu and May fail to disclose, let alone suggest, several of the recitations of claim 16 and, therefore, these claims are also patentable over the prior art of record. In addition to the recitations of claim 16 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, claim 27, as amended, recites a method for installing management software onto a remote client machine, comprising, attempting to initiate a connection at a server to the client machine, and if successful, transmitting an installation service from the server to the client machine, and executing the installation service, the executing independent of any installation program previously installed on the client machine, and if not

successful, secondarily attempting to initiate a connection at the server to the client machine, and if successful, transmitting an installation service from the server to the machine, and executing the installation service, the executing independent of any installation program previously installed on the client machine.

The Office action rejected claim 27 as well as dependent claims 28-41 as unpatentable over some combination of Luu, May, Hermann, and Lerche. In contrast to the recitation of claim 27 that executing the installation service is independent of any installation program previously installed on the client machine, Luu is directed to a system where a previously installed installation program on Luu's machine installs the software, not the Luu installation package. For at least this reason, applicants submit that claim 27, and dependent claims 28-41, by similar analysis, are patentable over the prior art of record. Applicants submit that claims 28-41 are also allowable for the additional patentable elements included in these claims.

Turing to the last independent claim, claim 42, as amended, recites a method for installing software onto a client machine, comprising, determining whether a user that is logged onto the client machine has sufficient security rights to have software installed on the client machine, and if so, executing a process at the client machine to install the software, and if not, initiating a connection at a server to the client machine, transmitting an installation service from the server to the client machine based on the connection, and executing the installation

service to install the software, the executing the installation service independent of any installation program previously installed on the client machine.

The Office action rejected claim 42 as well as dependent claims 43-51 as unpatentable over some combination of Luu, May, and Hermann. In contrast to the recitation of claim 42 that executing the installation service is independent of any installation program previously installed on the client machine, Luu is directed to a system where a previously installed installation program on Luu's machine installs the software, not the Luu installation package. For at least this reason, applicants submit that claim 42 and dependent claims 43-51, by similar analysis, are patentable over the prior art of record.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-51 are patentable over the prior art of record, and that the application is good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,

Albert S. Michalik, Registration No. 37,395
Attorney for Applicant
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE
Sammamish, WA 98074
425-836-3030 (telephone)
425-836-8957 (facsimile)